

Commissioner for Patents
Amendment dated June 10, 2004
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Art Unit: 2151
Examiner: Phillips
Docket: AUS000424US1

REMARKS/ARGUMENTS

Claims 1-21 were presented and examined. The Examiner objected to informalities in the specification, and the length of the abstract. The Examiner rejected claims 1, 8, and 15 under 35 USC § 112, second paragraph, as indefinite. Claims 1, 8, and 15 were rejected under 35 USC § 102(e), as being anticipated by Kwan, USPN 6,411,966. Claims 2, 9, and 16 were rejected under 35 USC § 103(a), as being unpatentable over Kwan in view of Johnson, USPN 5,113,519. The Examiner rejected claims 3, 4, 10, 11, 17, and 18 under 35 USC § 103(a), as being unpatentable over Kwan in view of Johnson, and further in view of Williams, USPN 5,781,908. Claims 5, 7, 12, 14, 19, and 21 were rejected under 35 USC § 103(a), as being unpatentable over Kwan in view of Berstis, USPN 6,182,122. Claims 6, 13, and 20 were rejected under 35 USC § 103(a), as being unpatentable over Kwan in view of Berstis, and further in view of Orbits, USPN 5,630,097. In this response, Applicant has amended claims 1, 6-8, and 13-21, and canceled claims 5 and 12. Claims 1-4, 6-11, and 13-21 remain pending.

Claim rejections under 35 USC § 112, Second Paragraph

The Examiner rejected claims 1, 8, and 15 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicant has amended each of the rejected claims to overcome the antecedent issue raised by the Examiner.

Claim rejections under 35 USC §§ 102(e), 103(a)

The Examiner rejected claims 1, 8, and 15 under 35 USC § 102(e), as being anticipated by Kwan. In response, Applicant has amended each of the independent claims. With respect to independent claims 1 and 8, Applicant has amended to incorporate the limitations of claims 5 and 12 (now canceled). Claims 5 and 12 as originally submitted were rejected under 35 USC § 103(a) as unpatentable over Kwan in view of Berstis. Applicant would respectfully request the Examiner to withdraw Berstis as a reference in this application under the provisions of 35 USC § 103(c). Specifically, because the subject matter of Berstis and the claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to a common

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entity, namely, IBM Corporation, Berstis cannot be cited as prior art to support a Section 103(a) rejection. Accordingly, Applicant would respectfully request the Examiner to withdraw Berstis and to reconsider and withdraw the prior art rejection of independent claims 1 and 8 as amended herein and all claims depending thereon.¹

With respect to independent claim 15, Applicant has amended to recite that the claimed computer program product includes code means for recording, in the change file, a sequence of keystrokes where the keystrokes produce the changes to the data file.² Because support for this amendment is found in the specification as filed at the paragraph beginning on page 8, line 20, no new matter is introduced by this amendment.

The cited references neither disclose nor suggest recording a sequence of keystrokes in a change file as a mechanism to reduce network traffic by sending the change file, in lieu of the entire file that has been changed, across the network to achieve coherency or synchronicity between a file on a client system and a file on a server system. Kwan teaches comparing a host's copy of a client data file to a DNS server's copy of the client data file. If differences are detected, a message is sent to the DNS server, where the DNS server can discern from the message the differences between its copy of the client data file and the host's copy. Kwan does not, however, teach or suggest that messages passed between a host and a DNS server indicate keystrokes that produced changes to the host's (or the server's) copy of the client data file. The changes in the client data file under consideration by Kwan are not the types of changes that are effected by user keystrokes. The client file of Kwan might, for example, reflect a change in IP address that occurred following a system boot or reset. In this case, a DHCP server assigns the IP address automatically. No user keystroke sequence is associated with changes of this type. More generally, Kwan is specifically interested in changes that effect the Domain Name Space. Unlike alterations to a database that occur as a user uses an application program, changes in domain name space data are not generally keystroke driven changes. Therefore, because the cited

¹ In the event that the Examiner rejects amended claims 1 and 8 using newly cited art, Applicant would request the Examiner to recognize that the new ground of rejection is not necessitated by Applicant's amendment since the amendment merely incorporates limitations that were presented in previously presented dependent claims (i.e., amended claims 1 and 8 merely recite what was previously recited in dependent claims 5 and 12). Therefore, any such rejection based on one or more newly cited references cannot be made final (MPEP 706.07(a)).

² Applicant has also amended claim 15 and its dependent claims to recite "code means" in lieu of method claim language that was present in the claims as originally submitted.

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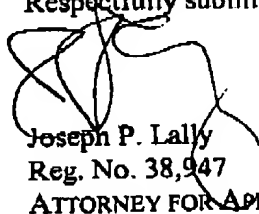
reference neither discloses nor suggests the limitations of claim 15 as amended herein, Applicant would request the Examiner to reconsider and withdraw the prior art rejection of claim 15 and all claims depending thereon.

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In this response, Applicant has addressed the Examiner's objections to the specification and abstract, claim rejections under 35 USC § 112, second paragraph, claim rejections under 35 USC § 102(e), and claim rejections under 35 USC § 103(a). Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Accordingly, Applicant would request the Examiner to withdraw the rejections, allow the pending claims, and advance the application to issue. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at 512.428.9872.

Respectfully submitted,



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